

REMARKS

In response to the Restriction Requirement dated January 18, 2007, the applicant has elected Species I claims (claims 3-4, 15, 17, 43, 46, and 48) for examination at this time. This election is being made with traverse, as will be detailed later below. The Examiner also indicated on page 2 of the Restriction Requirement that claims 23-41 will be examined along with any elected species, for which the applicant thanks the Examiner. New claims 54-58 are being added herewith, and it is kindly requested that claims 54-58 be examined along with elected claims 3-4, 15, 17, 43, 46, and 48 and claims 23-41, as will also be explained later below. The non-elected claims are being kept pending herein, with the request that they be rejoined for examination should the applicant's traversal of the Restriction Requirement be deemed persuasive and/or if a generic claim is found to be allowable.

With this response, claims 3-4, 15, 17, 43, 46, and 48, claims 23-41, and claims 54-58 are believed to be in condition for examination. Claims 1-58 are pending in the application.

I. Traversal

A. Restriction can be proper in limited circumstances

An application may properly be restricted to one of two or more claimed inventions if they are able to support separate patents and they are either *independent* or *distinct*. If a search and examination of an entire application can be made *without serious burden*, the Examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions. MPEP § 803. In referring to practice under 35 U.S.C. § 121, the MPEP notes "it becomes very important that the practice under this section be carefully administered," and goes on to state "IT STILL REMAINS IMPORTANT FROM THE STANDPOINT OF THE PUBLIC INTEREST THAT NO REQUIREMENTS BE MADE WHICH MIGHT RESULT IN THE ISSUANCE OF TWO PATENTS FOR THE SAME INVENTION." MPEP § 803.01 (emphasis in original). The concern is that the public should be able to rely on the assumption that upon expiration, the public will be free to use not only the invention claimed in the patent, but also modifications and variants thereof. MPEP § 804.

B. Claims are not independent

The term “*independent*” means that there is no disclosed relationship between the two or more subjects disclosed, that is they are unconnected in design, operation, or effect. MPEP § 802.01. Each of the independent claims 1, 2, 7, and 8 of the respective Species I-IV identified in the Restriction Requirement generally includes a conversion circuit to generate a transform that is a binary number composed of elements meeting certain criteria. The other independent claims in the respective Species I-IV also contain recitations directed towards a circuit and binary elements meeting certain criteria. Thus, the claims 1, 2, 7, and 8 and the other claims in Species I-IV are not independent in a manner that would make a Restriction Requirement proper.

C. Claims are not distinct

Claims are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one of the subcombinations is separately usable. It is respectfully submitted that these requirements for distinctness have not been met by the present Restriction Requirement. In particular, claims 1, 2, 7, and 8 are all covered by a same inventive concept--since very few changes distinguish one claim from the other.

Specifically, the claims of Groups I-IV do indeed overlap in scope. For example, the claims 1, 2, 7, and 8 each recite a conversion circuit to generate a transform that is a binary number composed of binary elements T[x]. Relatively slight changes/differences distinguish one claim from another, at least some of said differences being highlighted below (specifically, the value of x in bold text and underline):

- For claim 1: a binary number composed of 2^n-1 binary elements T[x]
with $x = \underline{1}$ to 2^n-1
T[2^n-1] T[2^n-2] ... T[x]... T[2] T[1]
- For claim 2: a binary number composed of 2^n binary elements T[x] with
 $x = \underline{0}$ to 2^n-1 :
T[2^n-1] T[2^n-2] ... T[x]... T[1] T[0]
- For claim 7: a binary number composed of 2^n-1 binary elements T[x]

with $x = \underline{1}$ to $2^n - 1$
 $T[2^n - 1] T[2^n - 2] \dots T[x] \dots T[2] T[\underline{1}]$

- For claim 8: a binary number composed of $2n$ binary elements $T[x]$
with $x = \underline{0}$ to $2^n - 1$
 $T[2^n - 1] T[2^n - 2] \dots T[x] \dots T[1] T[\underline{0}]$

Accordingly, since these claims overlap in scope and are variants of each other, it is respectfully submitted that they can be examined together since the requirements for distinctiveness for purposes of a Restriction Requirement have not been met.

D. The claims are so related as to present no serious burden to the Examiner

The Restriction Requirement contends that each of the Species I-IV “requires a particular conditions for conversion.” However, it has not been demonstrated that the claims in these species would require separate classification and searches in different subclasses. Indeed, all of the claims in the Species I-IV would probably be searched in the same class and subclasses, since there are relatively slight changes between the claims as explained above, and in particular differences between the values of x .

Further, the applicants’ attorney is unable to discern how searching the entire application would present a *serious burden* to the Examiner. For instance, by entering the Restriction Requirement, the Examiner is contending that while searching Species II (where $x = 1$ to $2^n - 1$), the Examiner would not search the same class/subclass of the other species (such as Species I) where $x = 0$ to $2^n - 1$. These are clearly overlapping in terms of the ranges of x , where a search of Species II (starting with $x = 0$) would encompass a search of Species I (where x starts at 1), for instance.

The contention of separate species in the Restriction Requirement leaves the applicant wondering whether acquiescing in the restriction requirement would result in an inadequate search of the art. By entering the Restriction Requirement, the Examiner is admitting that a search of claims in Species II, is *not* a legitimate area of search for claims in Species I, and

consequently should be estopped from later applying art classified with respect to Species II against the claims in Species I.

Accordingly, it is respectfully submitted that the claims in Species I-IV can be examined together, since their search and examination would not present a serious burden to the Examiner.

II. Discussion of the other claims

The Examiner is again thanked for agreeing to examine claims 23-41 along with the elected claims.

New claims 54-58 are being presented herein, and it is respectfully submitted that these newly added claims can also be examined along with the other claims. Specifically, new independent claim 54 has been written to generically cover embodiments present in each of the Species I-IV, by specifying the value of x in terms of a and b , where a and b being equal to 0 or 1. The dependent claims 55-58 then specifically recite the values of (a,b) .

Thus, a generic form of a claim corresponding to the elected claims has been presented and can be examined.

III. Conclusion

The Director is authorized to charge any additional fees due by way of this response, or credit any overpayment, to our Deposit Account No. 19-1090.

All of the claims remaining in the application are believed to be allowable. Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,
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